Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte WERNER VEIT, JOSEF FENK and ROBERT GRANT-IRVINE

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Appeal No. 2000-0702
Application 08/653,306

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ON BRIEF

_____

Before FLEMING, LALL, and BARRY, Administrative Patent Judges.

LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 4 and 6, the only pending claims in the application.

According to Appellants, the disclosed invention is related to a circuit configuration for generating an output signal being orthogonal to an input signal, a circuit configuration for generating a signal having a frequency being double that of an input signal, and a circuit configuration for generating two

output signals being orthogonal to one another. A further understanding of the invention can be achieved from the following claim.

4. A circuit configuration for generating two output signals being orthogonal to one another, comprising:

a delay device having an input to which an input signal is applied, an output at which an output signal is available, and a control input for controlling a time lag;

a multiplier device having inputs being coupled to the input and the output of said delay device and having an output;

a device for low-pass filtering being connected between the output of said multiplier device and the control input of said delay device, said low-pass filter being directly connected to said delay device; and

a master-slave toggle flip-flop following said multiplier device and having outputs at which two output signals being orthogonal to one another are available.

The Examiner relies on the following references:

Rein	5,015,872	May 14, 1991
Hamano et al. (Hamano)	5,066,877	Nov. 19, 1991
Naka[1] (Japanese)	2-125515	May 14, 1990
Kono[1] (Japanese)	03-136515	Jun. 11, 1991

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Rein in view of Naka or Kono.

[1] English translation is enclosed with the decision.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Rein in view of Naka or Kono and further in view of Hamano.

Rather than repeat the arguments of Appellants and the Examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have considered the rejections advanced by the Examiner and the supporting arguments. We have, likewise, reviewed the Appellants' arguments set forth in the brief.

We reverse.

Before entering into the claim analysis, we set below the guidelines set by the Federal Circuit regarding a rejection under 35 U.S.C. § 103(a).

The general proposition in an appeal involving a rejection under 35 U.S.C. § 103 is that an Examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a

whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). We are further guided by the precedent of our reviewing court that the limitations from the disclosure are not to be imported into the claims. In re Lundberg, 244 F.2d 543, 548, 113 USPQ 530, 534 (CCPA 1957); In re Queener, 796 F.2d 461, 464, 230 USPQ 438, 440 (Fed. Cir. 1986). We also note that the arguments not made separately for any individual claim or claims are considered waived. See 37 CFR § 1.192(a) and (c). In re Baxter Travenol Labs., 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) ("It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobviousness distinctions over the prior art."); In re Wiechert, 370 F.2d 927, 936, 152 USPQ 247, 254 (CCPA 1967)("This court has uniformly followed the sound rule that an issue raised below which is not argued in that court, even if it has been properly brought here

by reason of appeal is regarded as abandoned and will not be considered. It is our function as a court to decide disputed issues, not to create them.").

At the outset, we note (brief at page 10) that appellants elect to have claim 6 stand or fall with claim 4.

Now we consider the two combinations of references for the rejection of representative claim 4.

Rein and Naka

In response to Examiner's rejection of claim 4 (answer at pages 3 and 4) over this combination, Appellants argue (brief at page 12) that "[i]t is pointed out that an XOR gate [element 111 of Naka] is generally not interpreted as a multiplier by a person of skill in the art." The Examiner responds (answer at page 6) that "the Naka reference shows in Figures 3 and 4 that the XOR gate 111 provides an output signal (b) having twice the frequency of the input signal (a) by XORing the input signal (a) with a delayed input signal. Thus, the XOR gate 111 is seen as a 'multiplier device' because it operates as a frequency multiplier."

We disagree with the Examiner's characterization of element 111 of Naka as the recited multiplier. We note that the output (b) is the result of the operation of elements 251 and 111 and

cannot be ascribed to a function of element 111 alone. Moreover, we note that an exclusive OR (XOR) gate is a specialized OR gate, and both are known as adder devices, rather than multipliers. Therefore, Naka does not provide the recited multiplier device of claim 4.

Appellants further argue (brief at page 14) that "neither Rein nor Naka provide . . . a teaching, suggestion or incentive, absent hindsight judgment in view of this application." The Examiner responds (answer at page 8) that "[i]n this case, the Naka reference provides a clock signal (b) with a constant duty ratio and the Rein reference shows a clock pulse T coupled to the input of the master-slave flip flop. Thus, it would have been obvious . . . to employ the clock signal (b) of Naka as the clock signal (T) of Rein to provide a clock signal with a constant duty ratio so that the clock signal is always present without distortion for normal operation of the master-slave flip-flop." We disagree with the Examiner's position. The Federal Circuit has held that "[the] mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992) (citing

4In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).) "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d at 1087, 37 USPQ2d at 1239 (Fed. Cir. 1995). (citing W. L. Gore & Assocs., v. Garlock, Inc., 721 F.2d at 1551, 1553 220 USPQ at 311, 312-13 (Fed. Cir. 1983)). In the instant case, we find that neither Rein nor Naka discloses that one should be combined with the other. We further find that each reference contains a complete and different invention, and an artisian looking at either would not have found a reason to modify the other. Therefore, we agree with Appellants that, without the road map of the Appellants' invention, the artisan would not have been motivated to look at the two references for a combination to meet the recited limitation of claim 4.

Therefore, we do not sustain the obviousness rejection of claim 4 over Rein and Naka.

Rein and Kono

The Examiner rejects claim 4 under this combination at page 4 of the Examiner's answer. The Examiner uses the same reasoning as in the combination of Rein and Naka. The Examiner asserts that the exclusive OR gate (XOR) 3 of Kono is the recited

multiplier elepment. However, for the same rationale as above, we disagree with the Examiner's characterization of element 3 of Kono as the recited multiplier. The output 14 in Kono is not simply a result of the operation of element 3 but is the result of the operation of all the elements involved between input 11 and output 14. Also, we disagree with the Examiner for the motivation to combine Rein and Kono for the same reason as stated above. Therefore, we do not sustain the obviousness rejection of claim 4 over Rein and Kono.

With respect to claim 6, since the addition of the reference to Hamano does not cure the deficiency noted above, we do not sustain the obviousness rejection of claim 6 over Rein in view of Naka or Kono and further in view of Hamano.

In conclusion, we have not sustained under 35 U.S.C. § 103 the rejection of claim 4 over Rein in view of Naka or Kono, and the rejection of claim 6 over Rein in view of Naka or Kono and further in view of Hamano.

The decision of the Examiner under 35 U.S.C. § 103 is reversed.

REVERSED

MICHAEL R. FLEMING	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
PARSHOTAM S. LALL	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
LANCE LEONARD BARRY	)	
Administrative Patent Judge	)	

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